

REMARKS

Prior to this Reply, Claims 1-53 were pending. Through this Reply, no claims have been amended, added or cancelled. Accordingly, Claims 1-53 are now at issue in the present case.

I. Allowable Subject Matter

The Examiner objected-to Claims 5, 12, 13, 22, 25-27, 29, 44-46 and 53 as being dependent upon a rejected base claim. However, the Examiner indicated that such claims would be allowable if they were rewritten in independent form to include all of the limitations of their respective base claims and any intervening claims.

Instead of rewriting claims in independent form, Applicants offer the arguments presented below.

II. Claim Rejections

The Examiner rejected Claims 1, 2, 4, 6-11, 14, 16-21, 24, 26, 28, 30-40, 43 and 47-52 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,429,984 to Alex (hereinafter “Alex”).¹ Applicants respectfully traverse the rejection because the Examiner has failed to establish a *prima facie* case of obviousness in rejecting the claims.

As set forth in MPEP § 2143, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

¹ Applicants believe that any reference to Sacks et al. in the Office Action (see, e.g., pages 2 and 3) is a typographical error. Applicants’ position is supported by the language on page 10 of the Office Action, where the Examiner indicated that U.S. Patent No. 6,490,111 to Sacks et al. is prior art that has been made of record, but is not relied upon.

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

Applicants traverse the rejection because the Examiner has failed to show that Alex teaches or suggests all of the claim limitations.² Among other things, the Examiner has failed to address at least one claim limitation in each of the independent claims.

Specifically, with respect to independent Claims 1, 11, 21 and 30, the Examiner set forth her rejection on pages 2 and 3 of the Office Action. However, with respect to Claim 1, the Examiner has failed to show any teaching or suggestion in Alex of the following language: “wherein said test pattern comprises at least one of a higher data density than a data density of user data and a location on said magnetic disk having a greater than average susceptibility to thermal decay.”

With respect to Claim 11, the Examiner has failed to show any teaching or suggestion in Alex of the following language: “wherein said test pattern comprises at least one of a lower data density than a data density of user data and a location on said magnetic disk having a greater than average susceptibility to thermal decay.”

With respect to Claim 21, the Examiner has failed to show any teaching or suggestion in Alex of the following language: “identifying a sector of a magnetic disk having a magnetization that is less than an average magnetization for said magnetic disk.” Furthermore, the Examiner has failed to show any teaching or suggestion in Alex of the following language in Claim 21: “writing an early warning pattern to said sector.”

²It should be noted that Applicants do not admit that the Examiner has met her burden with respect to the other two requirements associated with establishing a *prima facie* case of obviousness. Accordingly, Applicants may address such requirements at a later time, if necessary.

With respect to Claim 30, the Examiner has failed to show any teaching or suggestion in Alex of the following language: “writing a test pattern having a greater susceptibility to thermal decay than a 1T pattern to a magnetic storage medium.”

With respect to independent Claims 36 and 47, the Examiner set forth her rejection on pages 3-5 of the Office Action. However, with respect to Claim 36, the Examiner has failed to show any teaching or suggestion in Alex of the following language: “said at least a first test pattern having a greater susceptibility to decay than user data located in a like data track.”

With respect to Claim 47, the Examiner has failed to show any teaching or suggestion in Alex of the following language: “wherein at least a first of said plurality of data tracks has a reduced magnetization capacity.”

As set forth in MPEP § 2143.03, “all words in a claim must be considered in judging the patentability of that claim against the prior art” (citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Clearly, the Examiner has not considered all of the words in the independent claims in judging their patentability against the prior art.

As set forth in MPEP § 2142, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. In view of the above, Applicants believe that the Examiner has failed to meet her burden. Accordingly, until the Examiner meets her burden, Applicants are under no obligation to submit any evidence of nonobviousness (MPEP § 2142).

For all of the above reasons, Applicants believe that independent Claims 1, 11, 21, 30, 36 and 47 are patentably distinguishable from Alex. For at least the above, reasons, Applicants submit that the claims that depend from the independent claims are likewise patentably distinguishable from Alex.

Many of the dependent claims are patentable for reasons in addition to those provided above. For example, with respect to Claims 2, 28, 43 and 52, the Examiner argues that Alex “teaches writing information to at least a first track of said magnetic disk at a first frequency, wherein said first frequency is higher than a nominal frequency” (Office Action at page 7). Applicants disagree.

In rejecting such claims, the Examiner cited Col. 10, lines 3-10 of Alex. The cited section of Alex discusses a test circuit 80 (see Fig. 10 of Alex) that is used to obtain the data illustrated in Fig. 1. Col. 4, lines 4-10 of Alex states:

Specifically, test circuit 80 includes a read-write analyzer 81 that supplies a signal to head 43 and that receives a readback signal from the head 43. Analyzer 81 supplies the readback signal (which is undergoing decay) to each of a spectrum analyzer 82 and an oscilloscope 83. Spectrum analyzer 82 and oscilloscope 83 are used by a user to manually detect the change in the readback signal in the frequency and time domains respectively.

Applicants are at a complete loss as to how the Examiner interprets the language in Col. 10, lines 3-10 of Alex to meet the limitations set forth in Claims 2, 28, 43 and 52. The above-quoted language relates to manually detecting changes in the frequency and time domains of the readback signal using a spectrum analyzer and an oscilloscope, respectively. There is no discussion of the frequency of the test pattern written onto the disk surface.

Claim 2 requires the following language: “wherein said step of writing a test pattern comprises writing information to at least a first track of said magnetic disk at a first frequency, wherein said first frequency is higher than a nominal data frequency for said track.” Claim 28 requires the following language: “wherein said step of writing an early warning pattern comprises writing data to said identified sector of said magnetic disk at a frequency greater than a nominal data frequency for data stored on a track comprising said identified sector.” Claim 43

requires the following language: “wherein said at least a first test pattern comprises a data frequency that is greater than a frequency of said user data.” Claim 52 requires the following language: “wherein said at least a first test pattern has a data frequency that is higher than a user data frequency for a like one of said plurality of data tracks.” Applicants submit that the cited portion of Alex fails to disclose the limitations of Claims 2, 28, 43 and 52.

The Examiner rejected Claims 3, 41 and 42 under 35 U.S.C. § 103(a) as being unpatentable over Alex (as applied to Claim 2), and further in view of U.S. Patent No. 6,091,559 to Emo et al. (hereinafter “Emo”). Applicants respectfully traverse the rejection.

Claim 3 states that “said at least a first track is located within a first zone, wherein said first frequency is a nominal data frequency for a second zone, and wherein said first zone is located towards an inner diameter of said magnetic disk relative to said second zone” (emphasis added). The Examiner admits that Alex does not disclose all of the limitations of Claim 3 (Office Action at page 9). However, the Examiner argues that Emo discloses the missing limitations. Applicants disagree.

The Examiner cites Col. 18, lines 20-41 of Emo. The Examiner states that “Emo teaches that each zone has its own frequency in order to optimize head to disc performance when performing read/write operations.” Even if this is true, there is no teaching in Alex or Emo of “said at least a first track located within a first zone, wherein said first frequency is a nominal data frequency for a second zone” (emphasis added). If the Examiner disagrees, Applicants request the Examiner to point to the specific language in Alex or Emo that supports her position.

For at least the above reasons, Applicants submit that Claim 3 is patentably distinguishable from Alex and Emo. For similar reasons, Applicants submit that Claims 41 and 42 are patentably distinguishable from Alex and Emo.

III. Additional Claim Fees

In determining whether additional claim fees are due, reference is made to the Fee Calculation Table (below).

Fee Calculation Table						
	Claims Remaining After Amendment		Highest Number Previously Paid For	Present Extra	Rate	Additional Fee
Total (37 CFR 1.16(c))	53	Minus	53	= 0	x \$18 =	\$ 0.00
Independent (37 CFR 1.16(b))	6	Minus	6	= 0	x \$86 =	\$ 0.00

As set forth in the Fee Calculation Table (above), Applicants previously paid claim fees for fifty-three (53) total claims and for six (6) independent claims. Accordingly, Applicants believe that no other fees are due. Nevertheless, the Commissioner is hereby authorized to charge Deposit Account No. 50-2198 for any fee deficiencies associated with filing this paper.

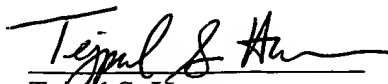
IV. Conclusion

It is believed the above comments establish patentability. Applicants do not necessarily accede to the assertions and statements in the Office Action, whether or not expressly addressed.

Applicants believe that the application appears to be in form for allowance. Accordingly, reconsideration and allowance thereof is respectfully requested.

The Examiner is invited to contact the undersigned at the below-listed telephone number regarding any matters relating to the present application.

Respectfully submitted,



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